

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office action mailed May 4, 2006, however, has tentatively rejected all claims. In response, claims 1 and 3 are amended, and claim 2 is canceled.

Response to Claim objections

Claim 18 is objected to because of the following informalities: Claim 18, line 2, there is no antecedent basic for “the electronic device.” Because claim 18 depends on claim 1, applicant amended claim 1 to overcome the objections.

Response to Rejections Under 35 U.S.C. §102

Claim 1 is amended to add the limitation that is directly supported by the original disclosure, including Figs. 1-2. As amended, claim 1 defines that a mounting assembly provides for fixing a main board on a housing of an electronic device. The mounting assembly comprises a base and a clip. The base has a first engaging portion, and the clip is disposed in the base slidably in a first direction and a second opposite direction. When moving in the first direction, the clip fixes the main board, and in the second direction, releases the main board. The clip comprises a second engaging portion and **a single actuating portion**. The second engaging portion engages the first engaging portion to limit the clip to only the first direction. The single actuating portion releases the first and second engaging portions, when receiving a force, enabling the clip to be moved in either the first direction or the second direction. Significantly, **the locating member is provided on the base to slidably dispose the clip on the base**.

In contrast, Scholder et al., discloses a clip (40) comprising **two actuating portions (42, 44)**. The clip (40) slides along the base (22). When the clip (40) is released to slide on the base (22), the actuating portions (42, 44) must be pull open. Moreover, a locating member (49) in Scholder et al. is disposed on the clip (40), but not disposed on the base. The position of the locating member (49) in Scholder et al is different from in the application.

For at least this reason, claim 1 of the application is not anticipated by Scholder et al. As claims 2-10, 12-14, and 16-18 depend from claim 1, they are not anticipated by Scholder et al either.

Response to Rejections Under 35 U.S.C. §103

The Office Action rejected claims 11 and 15 under 35 U.S.C. § 103(a) as allegedly obvious over Scholder et al in view of Rumney (US 6,752,276). Applicant submits that claims 11 and 15 patently define over the cited art for at least the same reasons as claim 1, from which they ultimately depend.

As a separate and independent basis for the patentability of claims 11 and 15, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious “for the purpose of completely holding the main board in the housing (Office Action, page 5). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art

that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock
Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added.) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a mounting assembly, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB
v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614,

1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

Again, Applicant believes claim 1 to be generic to all claims. Therefore, upon allowance of claims 1-18, all claims should be considered and allowed.

All claims are believed to be in condition for allowance, and the Examiner is respectfully requested to pass those claims to issuance. If the Examiner believes a teleconference will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney at 770-933-9500.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted ,

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